Gau 1642

MSK.P-035-US
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Sadelain et al.		
Serial No.:	08/940,544	Examiner: J. Burke	
Filed:	September 30, 1997	Art Unit: 1642	
For:	Fusion Proteins of a Single-Chain Antibody and CD28 and Uses Thereof		

RESPONSE TO RESTRICTION REQUIREMENT

Asst. Commissioner for Patents

Washington, D.C. 20231

Sir:

Responsive to the Restriction Requirement mailed October 4, 1999 for the above-captioned application, Applicants elect the claims of Group I, i.e., Claims 1-7, **with traverse**. For the reasons set forth below, Applicants request reconsideration of the restriction requirement and consideration of all of the claims.

One of the fundamental factors which must be taken into account when considering the appropriateness of a restriction requirement is the burden on the Examiner. Thus, as stated in MPEP § 803, "if the search and examination of an entrie application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions." (emphasis added) Here, the inventions of the four identified groups are all-related, and consideration of art relating to one is reasonably contemplated to lead to art about all of the inventions. In particular, most art which discloses a recombinant polynucleotide will also the discuss the protein or peptide for which it codes, because the ultimate expression of such a protein or peptide is probably why the polynucleotide was made in the first place. Similarly, it is reasonable to assume that the uses to which the

---

I hereby certify that this paper and the attachments named herein are being deposited with the United States Postal Service as first class mail in an envelope addressed to Asst. Commissioner for Patents, Washington, D.C. 20231 on November 3, 1999

November 3, 1999
Date of Signature

Marina T. Larson, PTO # 32,038

polynucleotide is put, as disclosed in the present application, will form the starting point for any search. It would be unreasonable to start searching for relevant art in a totally unrelated field. In this case, the search relating to the elected claims would search art related to the transduced cells and to the method of making such cells. Thus, it is not seen that considering all of the groups of claims presents a burden. This being the case, it is respectfully submitted that the Restriction Requirement should be withdrawn.

It is noted that the Restriction Requirement does not focuses on the specific structures of the invention, and their inter-relationship, but rather on generalized statements about polynucleotides and proteins. While these statements are correct, they do not establish that a burden would be imposed on the Examiner by consideration of all of the claims. For example, while it is true that the peptides could at least in theory be made by chemical synthesis, the size of the molecules argues against this as a likely approach to find in the art. Furthermore, the Examiner has provided no reasons why one would make such peptides other than in connection with a method such as disclosed and claimed in this application. Thus, even if one were to make the peptides by a different method, it would be for the same purpose and thus would be located in the same search.

It is further noted that there is substantial overlap between the classes indicated by the Examiner for the groups of claims. For example, US Patent No. 5,521,288 which claims a CD28Ig fusion protein is classified in both 536/23.4 and 530/387.3. In addition, the classification in this area does not appear so fixed that one could reasonably search a single class and consider it sufficient. Thus, US Patent No. 5,637,481 entitled "Expression vectors encoding bispecific fusion proteins and methods of producing biologically active bispecific fusion proteins in a mammalian cell" which claims (all in one application) expression vectors (i.e., DNA), cells transfected with the expression vector and a method of producing the fusion protein encoded by the expression vector is not classified in any of the classes cited by the Examiner.

For the foregoing reasons, Applicants respectfully submit that consideration of all of the claims of this application at the same time is appropriate.

Respectfully submitted,

Marina T. Larson
PTO Reg. No. 32,038
Attorney for Applicant
(970) 668-2050